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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/929,696 | 08/14/2001 | James Randall Gilmore | 3580-011343 | 8858 |

7590 07/29/2004

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| EXAMINER |
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MARCHESCHI, MICHAEL A

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| ART UNIT | PAPER NUMBER |
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1755

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,696

Applicant(s)

GILMORE ET AL.

Examiner

Michael A Marcheschi

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 20-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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The disclosure is objected to because of the following informalities:

The specification is objected to because the copending application is not updated (does not define the patent number of the parent application).

Appropriate correction is required.

Claims 20-22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 is indefinite as to the phrase “said medium containing...of said inert filler is less than” because this phrase does not make sense.

Claim 20 is also indefinite because the phrase “the critical particulate volume” lacks antecedent basis since a “critical particulate volume” has not been **literally** defined before.

Claim 20 is also indefinite because the examiner is unclear as to what “the critical particulate volume” encompasses, thus rendering the scope of the claim unclear.

Claim 20 is indefinite because the phrase “said visco-elastic abrasive medium” (part F) lacks antecedent basis since a “visco-elastic abrasive medium” has not been **literally** defined before. Although line 1 of this claim sets forth “a rheopectic **abrasive** visco elastic medium”, this does not provide antecedent basis for the phrase as written in part F.

Claim 21 is indefinite because the phrase “said visco-elastic abrasive” lacks antecedent basis since a “visco-elastic abrasive” has not been **literally** defined before. Although line 1 of claim 20 sets forth “a rheopectic **abrasive** visco elastic”, this does not provide antecedent basis for the phrase defined in claim 21.

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Claim 21 is also indefinite as to the limitation "visco-elastic abrasive is a material..." because the abrasives listed are not visco-elastic. The phrase "visco-elastics" should be canceled from the above limitation.

Claim 22 is indefinite because it depend on an indefinite claim.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either (1) Rhoades (191), (2) Rhoades (057) or (3) Rhoades et al. (247).

Rhoades (191) teach in column 3, line 30-column 10, line 40, a rheopectic abrasive visco-elastic medium which comprises a poly(borosiloxane) polymer carrier and a particulate abrasive (silicon carbide) having a size within the claimed range.

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Rhoades (057) teach in column 3, line 55-column 5, line 30, a rheopectic abrasive visco-elastic medium which comprises a poly(borosiloxane) polymer carrier and a particulate abrasive (silicon carbide) having a size within the claimed range.

Rhoades et al. (247) teach in column 3, line 30-column 8, line 35, a rheopectic abrasive visco-elastic medium which comprises a poly(borosiloxane) polymer carrier and a particulate abrasive (silicon carbide) having a size within the claimed range.

The references teach compositions which comprise all of the claimed components and although the exact claimed characteristics are not literally defined, these are seen to be inherent in the intermediate material (polymer carrier) and the final product (medium) because the same material is used (i.e. poly(borosiloxane) polymer carrier as the intermediate material) and the final product is also the same (mixture of poly(borosiloxane) polymer carrier and a particulate abrasive). In view of this, the same materials inherently yield the same results absent evidence to the contrary and thus the claims are anticipated by these references.

In the alternative, the claimed characteristics are expected and therefore obvious because these are seen to be expected (obvious) in the intermediate material (polymer carrier) and the final product (medium) because the same material is used (i.e. poly(borosiloxane) polymer carrier as the intermediate material) and the final product is also the same (mixture of poly(borosiloxane) polymer carrier and a particulate abrasive). In view of this, the same materials expectedly (obvious) yield the same results absent evidence to the contrary.

In view of the teachings as set forth above, it is the examiners position that the references reasonably teach or suggest the limitations of the rejected claims.

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Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548.

Evidence of unexpected results must be commensurate in scope with the subject matter claimed.

In re Linder 173 USPQ 356.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L Bell can be reached on (571) 272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MM
6/15/04



MICHAEL MARCHESCHI
PRIMARY EXAMINER